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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,358	04/16/2004	Fysh Dadd	COCH-0010-1	8101
22506 7590 02/12/2007 JAGTIANI + GUTTAG 10363-A DEMOCRACY LANE FAIRFAX, VA 22030			EXAMINER STOKLOSA, JOSEPH A	
			ART UNIT	PAPER NUMBER
			3762	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/825,358

Applicant(s),

DADD ET AL.

Examiner

Joseph Stoklosa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 12/21/2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7, 8, 14-20, 22-24, 27 and 28, are rejected under 35 U.S.C. 102(b) as being anticipated by Kuzma (U.S. Patent No. 6,119,044).
4. In regards to claims 1-3, Kuzma teaches of a device, comprising an elongate member including at least one electrode (see for example Figure 1, Abstract), and a tip member extending distally from a distal end of the elongate member (see for example Figure 4). The Kuzma reference also discloses the tip as comprising a distally tapered portion and a blunt end portion at a distal end of the tapered portion (see for example Figure 4), and further teaches of the tip member being resiliently flexible (see for example Abstract, col. 11 lines 39-42).
5. In regards to claims 7 and 8, Examiner takes the position that the tapered portion of the tip, as taught by Kuzma, is substantially frusto-conical in shape and tapers continuously (see for example Figures 3 and 4).
6. In regards to claim 14, Examiner takes the position that Kuzma teaches the tip member is capable of being integral with the elongate member (see for example Figure 15).

7. In regards to claim 15, Kuzma teaches of the tip member being mounted on the distal end of the elongate member (see for example Figure 14).
8. In regards to claim 16, Kuzma teaches of a tip member that includes a lumen therein (see for example Figure 14).
9. In regards to claims 17 and 18, the Kuzma reference teaches of a device wherein the elongated member includes a lumen therein for allowing a stiffening element to be inserted through said elongate member and for allowing a distal end of said stiffening element to extend into said lumen in said tip member (see for example Figure 16 and Abstract).
10. In regards to claim 19, the Kuzma reference teaches of a system that has a shape and size that allows the system to be inserted into a human cochlea (see for example Abstract and Figure 16).
11. In regards to claim 20, the Kuzma reference teaches of a system wherein the tip member inherently has a substantially uniform bending stress distribution in an axial direction, since the tip is of one material and circular and therefore has uniform bending stress (see for example Figure 4).
12. In regards to claim 22, the Kuzma reference teaches of a system for applying stimulation to a desired tissue (see for example Abstract).
13. In regards to claims 23, 24, 27 and 28, claims 23, 24, 27 and 28 have similar limitations as to claims 1, 19 and 20, and thus are rejected for similar reasons.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 5, 6, 12 and 13, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuzma (U.S. Patent No. 6,119,044).

17. In regards to claim 5, Kuzma teaches of a barrel portion having a length (L8) that is 0.3 mm, which Examiner interprets as being about 0.4 mm. Similarly, in regards to claim 6, Kuzma teaches of the barrel portion having a diameter (L6) that is 0.6 mm, which Examiner interprets as being about 0.45 mm in diameter. Or in the alternative, Examiner takes the position that the dimensions of claims 5 and 6 would have been obvious modifications to system as taught by Kuzma.

18. In regards to claims 12 and 13, Examiner takes the position that the blunt end portion of the distal tip can be interpreted as part-ellipsoidal or part spherical in shape (see for example Figure 6). Or in the alternative, Examiner takes the position that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system as taught by Kuzma to include the limitations as specified in claims 12 and 13 to enhance efficiency and effectiveness of the system.

19. Claims 4, 9, 10, 11, 21, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma.

20. In regards to claims 4, 21, 25 and 26, Kuzma does not specifically teach that the elongate member has a diameter greater than the diameter of tip member's barrel portion, Examiner takes the position that such a configuration is well known in the art. Further, although the Kuzma reference discloses the use of silicone rubber (see for example col. 10 lines 58-62), the reference does not specifically teach of the use of a liquid silicone; however, Examiner takes the position that the use of liquid silicone is well known in the art and a modification of the Kuzma reference to include liquid silicone would have been obvious to one having ordinary skill in the art, since it is known in the art to provide efficient and effective operation.

21. In regards to claims 9-11, (Examiner interprets the dimensions of claim 9 as the length of the tapered portion of the tip member) Examiner takes the position that although the Kuzma reference teaches of elongated tapered device, it does not specifically teach of the exact dimensional parameters as specified in claims 9-11; however, Examiner takes the position that it would have been obvious to one having

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ordinary skill in the art at the time of the invention to modify the system as taught by Kuzma with the dimensional parameters as specified in claims 9-11, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

22. Applicant's arguments filed 12/21/2006 have been fully considered but they are not persuasive.

23. The applicant argues that the cited Kuzma reference of Col. 22, lines 39-42, do not disclose a resiliently flexible tip.

24. Kuzma does indeed teach either explicitly or impliedly a resiliently flexible tip. Kuzma states, "a soft tip, 37, having a depth of distance L8, is typically formed from LSR-25..." LSR-25 is a form of liquid silicone rubber and Examiner takes the position that liquid silicone rubber is indeed resiliently flexible. Resilient is defined by Dictionary.com as returning to original form or position after being bent, compressed or stretched. Dictionary.com defines flexible as capable of being bent, usually without breaking; easily bent. LSR is comprised of material that will return to original form when compressed and therefore is also flexible. Applied Silicone Corporation describes LSR to be a high strength, flexible elastomer with a tensile strength of 700 psi, 400% elongation, and tear strength of 400 psi (see attached product information sheet,

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Description). In addition, it is noted that the claims do not state that the "resiliently flexible tip" is resilient when "BENT," but just uses the broad term "resilient."

25. The applicant argues that the cited Fig. 4 of Kuzma does not teach a tapered portion as claimed.

26. Kuzma clearly teach a tapered portion as set forth in Fig. 4, 12, and Col 12, line 12).

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuzma (U.S. Patent No. 6,195,586).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Stoklosa whose telephone number is 571-272-1213. The examiner can normally be reached on Monday-Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

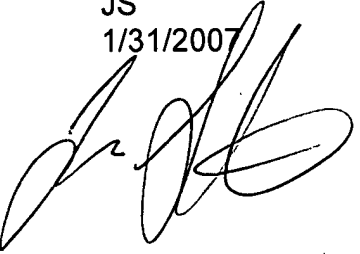
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph Stoklosa
Examiner
Art Unit 3762

JS

1/31/2007




George Curran
Primary

2/5/7